

REMARKS

Applicants respectfully request consideration on the subject application. This Response is submitted in response to the Office Action mailed August 15, 2007. Claims 1-14 and 27 were rejected. In this Amendment, the Abstract of the disclosure and claims 1 and 14 have been amended. Claim 27 has been cancelled. Claim 40 is newly presented.

Objections to the Specification

The Examiner objected to the Abstract of the disclosure because the phrase “a decision support method comprising: for two or more pre-defined criteria and one or more pre-defined and ordinally ranked categories for each criterion” is confusing with multiple “ands”. The Examiner objected that it is also not clear from this phrase what the method is supposed to do. The Examiner objected also that the subsequent phrase, “a method for determining a point value for each category on each criterion by ordinal pairwise ranking of profile pairs, wherein each profile comprises two or more of the criteria, each criterion associated with one of the categories for that criterion”, is also confusing. Applicants have amended these two phrases to address the Examiner’s objections. Specifically, these two phrases, which originally constituted a single sentence linked by multiple “ands”, have been re-written as six separate sentences, and further amended also.

The Examiner objected also that s/he can barely conclude from the original Abstract that the application concerns a decision support method with ordinal ranking of profiles. Applicants anticipate that it is now clear to the Examiner from the amended Abstract that the application concerns a method, using ordinal pairwise ranking of profile pairs, for obtaining a point value for each category on each criterion and/or a ranking of all possible profiles and/or a ranking of a subset of all possible profiles. As explained in our previous Remarks, these three outputs, as also noted in Claims 2-4, are all useful, concrete and tangible. Specifically, they are associated with Additive Points Systems.

Accordingly, Applicants respectfully request withdrawal of the objections to the specification.

Claim Objections

The Examiner objected to claims 14 and 27 because of the following informalities. Claim 14 recites "A decision support system comprising: two or more pre-defined criteria stored in data memory, each ...". The Examiner contends that criteria are not a physical component of the system and, as such, the criteria should not be recited in the claim body. Claim 27 is objected to for the same reason as claim 14.

Applicants propose to amend claim 14 to include "... a data memory having stored thereon two or more predefined criteria, each criterion ...". Claim 14 now includes the two physical components of a data memory and a processor.

Applicants propose to cancel claim 27.

Accordingly, Applicants respectfully request withdrawal of the objections to the specification.

35 U.S.C. § 112 Rejections

The Examiner has rejected claims 1-13 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

In particular, the Examiner submits that the phrase in the preamble of claim 1, “for two or more pre-defined criteria and one or more pre-defined and ordinally ranked categories for each criterion, and for two or more profiles, each profile comprising a set of two or more of the criteria and each criterion in the set associated with one of the categories for that criterion”, is confusing with multiple “ands”. The Examiner submits that it is also not clear from this phrase what the requirement is in the preamble. Applicants have amended the preamble of claim 1 to address the Examiner’s rejections.

The Examiner also submits that claim 1 recites the limitation “comprises the ordinal pairwise ranking of profile pair” and that there is insufficient basis for this alleged limitation.

Applicants propose to replace “the ordinal pairwise ranking...” with “an ordinal pairwise ranking ...”.

Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 112.

35 U.S.C. § 101 Rejections

The Examiner has rejected claims 1-14 and 27 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. The Examiner submits that claims 1-14 and 27 fail to provide a concrete result. Applicants disagree.

In particular, claims 1, 14 and 27 recite “receiving from the decision maker an ordinal pairwise ranking of the profiles”. The Examiner contends the decisions received from the decision maker lack concreteness, i.e. that given the same profiles to the same decision maker, the pairwise ranking can be different, and hence that the result is based on subjective criteria, and is not repeatable.

The Examiner is correct “that given the same profiles to the same decision maker, the pairwise ranking can be different”. This is entirely appropriate, as different decision makers may be expected to ordinally pairwise rank profiles differently, as such rankings are based on decision makers’ idiosyncratic and subjective judgments.

However, a significant feature of the claimed invention is that from the same set of ordinal pairwise rankings of profiles, as may be obtained from different decision makers or the same decision maker on a repeated basis, the claimed invention will produce the same outputs, and thus the outputs are

repeatable. In other words, these ordinal pairwise rankings of profiles may be thought of as the inputs to the claimed invention, and thus from the same inputs, the same outputs will be produced by the claimed invention, and so the outputs are repeatable.

In addition to being repeatable, these outputs are useful, concrete and tangible. Claim 1 requires: "solving a system of equalities/inequalities that represent the ordinal pairwise rankings of profile pairs to obtain at least one output." Applicants submit that at least one output is a useful, concrete and tangible result.

The Examiner has also rejected claims 1-14 and 27 under 35 U.S.C. § 101 because of preemption. In particular, the Examiner submits neither the claims nor the specification limit the invention to any practical invention.

MPEP 2106 IV,C, 2, (2) states:

"For purposes of an eligibility analysis, a physical transformation "is not an invariable requirement, but merely one example of how a mathematical algorithm[or law of nature] may bring about a useful application." AT&T, 172 F.3d at 1358-59, 50 USPQ2d at 1452. If USPTO personnel determine the claim does not entail the transformation of an article, then USPTO personnel shall review the claim to determine it produces a useful, tangible, and concrete result. In making this determination, the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather on whether

the final result achieved by the claimed invention is “useful, tangible, and concrete.” (Emphasis added).

Even though the current application describes mathematical operations being performed, the final result achieved by the claimed invention is a useful, tangible, and concrete decision support system.

As described in the specification, on page 1, lines 14-15, decision support systems provide a relatively simple solution to the pervasive problem faced by decision makers with multiple criteria, attributes, or characteristics to consider when ranking alternatives.

The decision support system is “useful” in that the invention is (1) specific (2) substantial and (3) credible. As described in the specification, a surgery patient or immigration agency may use the decision support system to arrive at a decision using multiple criteria. A third example is the determination of the best site for a building relative to other sites being considered.

Applicant’s remarks do not admit an unbounded list of applications. For example, the system would not be applicable in a scenario where point values or rankings of profiles are not required or desired.

“[A]n application of law a law of nature or mathematical formula to a....process may well be serving of patent protection.” Diehr, 450 U.S. at 187, 209 USPQ at 8.

The decision support system utilizes mathematics to create a system that decision makers can utilize. The tangible requirement does not necessarily mean

that a claim must either be tied to a particular machine or apparatus or must operate to change articles. *See* MPEP 2106 IV,C, 2, (2)(b).

As mentioned above, the decision support system creates a concrete result in that at least one output comprises a ranking of a subset of all possible profiles. A decision maker, can easily arrive at the same result if the criteria and variables are identical. Therefore, the process is certainly repeatable and “concrete”.

Accordingly, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 101.

35 U.S.C. § 102 Rejections

The Examiner has rejected claims 1-14 and 27 under 35 U.S.C. § 102 as being anticipated by Hansen et al (WO 2004/111906 A1).

Applicant respectfully refers the Examiner to MPEP §§ 1857.01 and 1893.01(a) which clearly states that Applicant has 30 months to file the basic filing fee and submit a copy of the international application.

The Examiner argues that Applicant cannot claim the PCT filing date as the effective filing date because the filing date of national stage is more than 18 months from the PCT filing date. Applicant respectfully submits that there is no such 18 month requirement in the law and no section of the MPEP has been cited by the Examiner.

As shown in the record, the United States Patent and Trademark Office has accepted the current application under 35 U.S.C. 371 in a document mailed on July 18, 2006 by Paulette R. Kidwell. Thus, the international filing date of the

PCT application is the effective filing date of this application as described in MPEP 1896.

The same document entitled "NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C 371 AND 37 CFR 1.495" shows all requirements of 35 U.S.C. 371 completed on June 2, 2006.

Applicant respectfully submits the Applicant's own PCT publication is not a valid prior art reference because all the requirements of 35 U.S.C 371 have been fulfilled in a timely manner as acknowledged by the U.S.P.T.O. itself.

Applicant respectfully submits that the present application is in condition for allowance. If the Examiner believes a telephone conference would expedite or assist in the allowance of the present application, the Examiner is invited to call the undersigned at (408) 720-8300.

Please charge any shortages and credit any overages to Deposit Account No. 02-2666. Any necessary extension of time for response not already requested is hereby requested. Please charge any corresponding fee to Deposit Account No. 02-2666.

Respectfully submitted,

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